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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,712	09/13/1999	ROBERT W. ESMOND	0609.4440002	4740

7590

04/07/2004

ROBERT W. ESMOND  
302 BLAIR COURT, N.W.  
VIENNA, VA 22180

EXAMINER
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KIM, VICKIE Y

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/394,712

Applicant(s)

ESMOND ET AL.

Examiner

Vickie Kim

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,7 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,20 and 25 is/are rejected.
- 7) ☐ Claim(s) 7,21-24 and 26-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 22.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Status of Application***

1. Acknowledgement is made of amendment filed September 05, 2003. Upon entering the amendment, the claims 1 and 20-29 are amended and the claims 2-6 and 8-19 are canceled. New claims 30-35 are added.
2. The claims 1, 7, 20-35 are pending and presented for the examination.
3. Acknowledgement is made of interference request filed on Jan. 02, 2001.

***Claim Rejection-35 USC 135(b)***

4. Claims 1, 20 and 35 are rejected under 35 U.S.C.135(b) since the amendment (filed 8/11/03) to the claims does not comply with the requirements of 37 CFR 1.607.

The claims 1, 20 and 25 are rejected under 35 USC 135(b) because the claims(see paper no.23, 8/11/03 ) identified as corresponding to the proposed count was added or amended to the application by the amendment more than one year after issuance of the patent(US6191154 issued on Feb.20, 2001). Although newly added species (i.e. ciglitazone or englitazone) into the independent claims 1, 20 and 25 are embraced by the generic term "thiazolidinedione, the said species are patentably distinct from other claimed species (e.g. troglitazone, piglitazone, 5-[4-[2-[N-methyl-N-(w-pyridyl)amino]ethoxy]benzyl]thiazolidine-2,4-dione ). Since applicant fails to copy the claims or present the claims, and none of the claims which were present in the instant application prior to expiration of the one-year period meets the "substantially for the same subject matter" test, the claims presented or identified as corresponding to the

Art Unit: 1614

proposed cound should be rejected under 35 USC 135(b), see *MPEP* 2307.02 at pages 2300-14 and 2300-15.

### ***Allowable Subject Matter***

5. Claims 7, 21-24 and 26-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Since the claims 7, 21-24 and 26-35 are drawn solely to those agents that were amended previously and presented prior to expiration of the one-year period, the claims would be allowable if it overcome the objection set forth immediately above.

For instance, claims 7 and 34-35 would be allowable since it is drawn solely to the agent being troglitazone. Claims 21-22, 26-27, 30, 32 would be allowable since it is drawn solely to the agent being piglitazone. Claims 23-24, 28-2931 and 33 would be allowable since it is drawn solely to the agent being 5-[4-[2-[N-methyl-N-(w-pyridyl)amino]ethoxy]benzyl]thiazolidine-2,4-dione.

### ***Conclusion***

6. No claim is allowed.

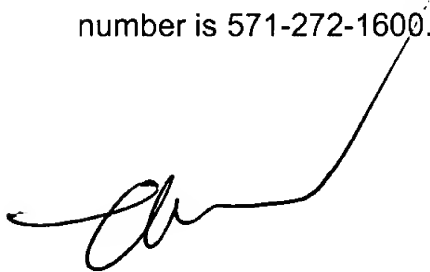
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1614

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579(fax: 571-273-0579). The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 571-272-0584. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to be 'Vickie Kim', with a long, sweeping horizontal line extending to the right.

Vickie Kim  
Primary Patent examiner  
April 2, 2004  
Art unit 1614